

REMARKS

The Office Action dated April 27, 2006, has been received and carefully considered. Reconsideration of the outstanding objections/rejections in the present application is respectfully requested based on the following remarks.

Claim Rejections 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,614,787 ("Jain"). Applicant respectfully traverses these rejections for at least the reasons that Jain fails to disclose each feature recited in the claims and the Examiner has failed to provide motivation as to why one of ordinary skill in the art would have been motivated to modify Jain.

As admitted by the Examiner, Jain does not disclose multicasting a single message to a group address. Office Action, p. 5. In addition, Applicant respectfully submits that Jain also does not disclose "multicasting the single message to a group address" where the message is a plurality of "receiver information for each multicast source system." In contrast Jain discloses "the VLAN is registered using GVRP (group VLAN registration protocol)." See, Jain col. 8, lines 40-42. Thus, Jain discloses using GVRP to communicate registration

information from receivers to hosts and fails to disclose "the multicasting the single message to a group address" as required by the claims. Rather, Jain discloses forwarding multicast packets from hosts to clients and reducing multicast packet traffic "by aggregating VLAN (virtual local area network) context." See abstract. Accordingly, Jain does not disclose or suggest using multicast protocols to "multicast the single message" where the plurality of respective records are aggregated into a single message. In contrast, Jain is directed to a "second intermediate device [perceiving] having only a single VLAN registered to receive the multicast packet." Abstract.

The Examiner asserts that "multicasting to a group address is well known in the art of multicasting, and accordingly, it would have been obvious to one of ordinary skill in the art to multicast the 'aggregate list of the multicast registration information' to a group address." Office Action, pages 2-3. The Applicant respectfully disagrees. Multicasting is directed generally at efficiently distributing information to multiple receivers by using group addresses instead of unicasting or sending the packets directly to each individual receiver. Neither Jain nor what is well known in the art of multicasting

disclose or suggest using multicasting an aggregated record to a group address from receivers to multicast source systems.

Applicant respectfully submits that Jain also does not disclose aggregating the plurality of respective records into a single message. Jain discloses that intermediate device 204 (a switch -- col. 6, lines 6-8) "combines or aggregates" the multicast registration information. Col. 7, lines 55-60. This aggregated information is a new virtual VID. Col. 8, lines 3-10. The VID is not a message, but an address for the switch 204 to send multicast messages when they arrive. As discussed above "the VLAN is registered using GVRP")." See, Jain col. 8, lines 40-41. Group addresses are used in the context of multicasting, not the registration of VLANs. In contrast, Applicant's claims recite "aggregating the plurality of respective records into a single message" and "multicasting the single message to a group address." Applicant respectfully submits that the rejection is improper for at least this reason.

In addition, Applicant respectfully submits that the Examiner has not provided proper motivation to modify Jain. The stated reason is that it would have been obvious in order to provide a database (of aggregated VIDs) at various other locations. Office Action, p. 5-6. However, even if one were to desire to provide a database of VIDs at various locations, the

Examiner has not provided a motivation for why the database would be provided at various locations by sending the database via a multicast of a single message. If Jain were modified to move the aggregate list of multicast registration information to a different location then it would be multicasting non aggregated information until it reached the database where it is aggregated. See fig 3, step 306 and fig 5, step 504. The aggregation and storage occur at the same point. Any network registration traffic upstream from the database is using GVRP and not multicasting aggregated information to a group address. Of course, Jain does not disclose sending the database via any sort of message and the Examiner has not provided a motivation why one of ordinary skill would do so either. For at least this reason, Applicant respectfully submits that the rejections are improper and requests that they be withdrawn.

Applicants respectfully submit that under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. Id. Obviousness cannot be established

by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or motivation to do so. Id. However, the motivation cannot come from the applicant's invention itself. In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. Id.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re

Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v.

Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. Ruiz v. A.B. Chance Co., 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

Each of the independent claims recite similar or analogous features as those discussed above. For at least this reason the rejection of each independent claim is improper and Applicant respectfully requests that the rejections be withdrawn. Likewise, the dependent claims contain the features recited in each independent claim and their rejection is improper for at

least this reason. Applicant respectfully requests that the rejections of the dependent claims also be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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